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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,960	08/18/2003	Patrick A. Hawkins	558.008US1	4188
21186 7590 04/28/2009 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
EPPS, TODD MICHAEL				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/642,960

Applicant(s)

HAWKINS, PATRICK A.

Examiner

Todd M. Epps

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-65 is/are pending in the application.
4a) Of the above claim(s) 54-65 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 36-53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/CIS)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

This is the first Office Action after Request for Continued Examination (**RCE**) for serial number 10/642,960, Mounting Device, filed on August 18, 2003.

Election/Restrictions

Newly submitted claims 54-65 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 36-53, drawn to subcombination, classified in class 248, subclass 74.1.
- II. Claims 54-65, drawn to combination (system), classified in class 248, subclass 65.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-65 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 36-53 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,679,461 to Hawkins in view of U.S. Patent No. 5,172,097 to Arnold.

Hawkins '461 discloses all of the limitations in the claims except for the plate structure disposed over the side surfaces. Nevertheless, Arnold '097 discloses a cover (30) with lips (31) over the unit (10). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 in view of Burgess '089 to include the lips as taught by Arnold '097 because one would have motivated to provide a means for preventing dirt / moisture from running into the interior of the support structure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36-40, 42-49, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,855,342 to Hawkins et al. (Hawkins) in view of U.S. Patent No. 7,102,089 to Burgess et al. (Burgess); and in further view of U.S. Patent No. 4,819,795 to Swaney.

Hawkins '342 discloses a support device adapted to support structures on a rooftop surface (as shown in Figure 5, see col. 5, lines 46-52), the support device (fig. 1) comprising: a foam base (10- col. 3, lines 20-33) including a top surface, sides and a footprint (bottom), the foam base to be installed on the rooftop with the footprint on the rooftop surface; wherein the foam base defines a recess extending through it along the top surface; at least a channel / strut (50) to couple to the structures to be supported on the rooftop surface; wherein the channel that is strut-like extends through the base between the two portions of the base; and the elongated strut includes a channel shaped cross section with a bottom strut surface, a first strut side surface, a second strut side surface with a first strut lip extending along the first strut side surface and oriented approximately parallel to the bottom strut surface, a first strut side surface, a second strut lip extending along the second strut side surface and oriented approximately parallel to the bottom strut surface; and wherein the elongate strut has an approximately rectangular cross section, the cross section taken orthogonal to the length of the elongate strut.

However, Hawkins '342 fails to teach a rigid (plate) structure, wherein at least a portion of the rigid (plate) structure disposed on the top surface and coupled with the support structure. Nevertheless, Burgess '089 discloses a plate structure (145a), wherein the plate structure includes metal sheet; wherein at least portion of the plate structure disposed on the top surface and disposed within the recess; wherein the plate structure is a substantially rigid plate structure, and further comprising a fastener that fasten the plate structure with the support structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 with a rigid structure as taught by Burgess '089 wherein doing so would provide thereof for a better design consideration.

Hawkins '342 fails to teach wherein at least one elongate strut is defined by the plate structure. Burgess '089 discloses an elongate strut is defined by the plate structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified a strut of Hawkins '342 with the plate as taught by Burgess '089 to formed by surfaces of the plate into one piece to save manufacturing costs. In re Larson, *340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)*.

Furthermore, Hawkins '342 in view of Burgess '089 fails to disclose wherein a plate structure disposed onto at least a portion of the side surfaces. Nevertheless, Swaney '795 discloses a cover (39) with lips (41) disposed onto at least a portion of the unit. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the support device of Hawkins '342 in view of Burgess '089 to include the lips as taught by Swaney '795 because one would have

motivated to provide a means for preventing dirt / moisture from running into the interior of the support structure.

Claims 41, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins '342 in view of Burgess '089, in further view of Swaney '795, and in further view of U.S. Patent No. 6,888,977 to Wong et al (Wong).

Hawkins '342 in view of Burgess '089 fails to teach wherein the fastener includes adhesive. Nevertheless, Wong '977 discloses a support plate with adhesives underneath as a fastener, and disposed between the support plate and the support structure. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the support structure and plate of Hawkins '342 in view of Burgess '089 and in further view of Swaney '795 with the adhesive as taught by Wong '977 wherein doing so would provide thereof for additional strength to hold the plate down.

Response to Arguments

Applicant's arguments filed on April 13, 2009 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Todd M. Epps whose telephone number is (571) 272-8282 – or – whose e-mail address is Todd.Epps@uspto.gov. The examiner can normally be reached on M-F (7:30-4:30).

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T.M.E./

Todd M. Epps
Patent Examiner
Art Unit 3632
April 25, 2009

/Alfred Joseph Wujciak III/

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Primary Examiner, Art Unit 3632